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REMARKS

Entry of this amendment is proper because it narrows the issues on appeal and does not require further search by the Examiner.

Claims 14-16, 18-20, 22-23, 26-36 and 38-39 are all the claims presently pending in the application. Claims 19, 26, 28 and 35 have been amended to further define the claimed invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Applicant gratefully acknowledges that claims 14-16, 18 and 22 are allowed, and that claims 19-20, 23 and 38 are objected to and would likely be allowed if the objection is addressed. However, Applicant submits that all of the claims are allowable.

Claims 28 and 35 stand rejected under 35 U.S.C. § 112, second paragraph as indefinite.

Claims 26-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Geniryu (JP No. 10-151794) in view of Nemoto et al. (U.S. Patent No. 6,025,213) in view of Yamada et al. (U.S. Patent No. 6,239,490 B1) further view of Oshio et al (U. S. Pat. No. 6,274,890). Claim stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Geniryu, Oshio and Yamada.

These rejections are traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention (e.g., as recited in claim 26) is directed to a semiconductor light-emitting apparatus including a base, first and second bonding pads formed on a first surface of the base, a light-emitting element formed between the first and second pads on the first surface of the base. The light-emitting element includes a substrate, a light-emitting layer formed on the substrate, and a first electrode disposed on an opposite side of the light-emitting layer from the base and comprising a light non-transmissible material for reflecting

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light from the light-emitting layer through the base. The apparatus further includes a sealing resin formed on the base and the light-emitting element.

Conventional light-emitting devices may include a fluorescent material in the sealing resin. However, the sealing resin undergoes a color change due to heat generated by the light-emitting device, causing a change in the color of the light emitted from the device (Application at page 3, lines 19-23).

The claimed invention, on the other hand, includes a fluorescent material which is disposed in said base and is adjacent to said substrate and on an opposite side of said substrate from said light-emitting layer. (Application at Figure 7; page 7, line 18-page 8, line 3). This design allows all of the light emitted from the light-emitting semiconductor to be absorbed, resulting in the emission of a constant color. Thus, the invention is able to obtain a highly reliable and high performance light emitting device and apparatus (Application at page 19, lines 1-21).

The prior art references do not appear to teach or suggest these novel features.

II. THE 35 U. S. C. §112, SECOND PARAGRAPH REJECTION

The Examiner alleges that claims 28 and 35 are indefinite. Applicant submits, however, that these claims are adequately enabled and are clearly and distinctly claim the subject matter regarded as the invention.

Specifically, claims 28 and 35 have been amended to address the Examiner's concerns. Therefore, these claims are clear and not indefinite.

Therefore, the Examiner is respectfully requested to withdraw this rejection.

III. THE GENRIYOU, NEMOTO, YAMADA AND OSHIO REFERENCES

The Examiner alleges that Genriyou would have been combined with Nemoto, Yamada and Oshio to form the claimed invention of claims 26-36, and that Genriyou would have been combined with Oshio and Yamada to form the claimed invention of claim 39. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Genriyou discloses a light-emitting device which is intended to stabilize light-emitting

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characteristics and to improve light utilization efficiency, by forming a light taking-out part side and an electric connection part side (Genriyou at Abstract).

Nemoto discloses a semiconductor light-emitting device for emitting light to a semiconductor substrate in the upper direction and a package window portion formed of a transparent heat sink. The device is bonded to the package window portion in accordance with an interconnection pattern (Nemoto at Abstract).

Yamada discloses a p-contact for a group III nitride semiconductor device. The p-contact is formed by depositing an electrode layer of palladium on an exposed surface of the contact layer in the device (Yamada at Abstract).

Oshio discloses a semiconductor light emitting device which includes a semiconductor light emitting element, and a resin stem having a thermosetting resin on the resin stem so as to cover the entire upper surface and continuous upper part of side surfaces of the resin stem to a predetermined depth (Oshio at Abstract).

Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, these are directed to different problems. Therefore, certainly no person of ordinary skill in the art would have considered combining these references, absent impermissible hindsight.

Further, the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, nowhere do these references teach or suggest their combination as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, none of these references teaches or suggests "*a fluorescent material which is disposed in said base and is adjacent to said substrate and on an opposite side of said substrate from said light-emitting layer*" as recited, for example, in claim 26 (e.g., and similarly recited in claim 39). As noted above, this design allows all of the light emitted from the light-emitting semiconductor to be absorbed, resulting in the emission of a constant color. Thus, the invention is able to obtain a highly reliable and high performance light emitting device and apparatus (Application at page 19, lines 1-21).

Clearly, the Examiner concedes that neither Genriyou, Nemoto, nor Yamada teach or suggest this feature. However, the Examiner alleges that this feature is taught by Oshio. The Examiner is clearly not correct.

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Indeed, Oshio merely teaches that a fluorescent material is mixed into an adhesive 3. However, heat from the light-emitting element causes a change in the adhesive, affecting the color of the light emitted by the device.

The claimed invention, on the other hand includes a fluorescent material in the base (e.g., see Application at Figures 7 and 8). The allows the claimed invention to prevent yellowing or browning caused by heat from the light-emitting element.

Specifically, the Examiner attempts to rely on Figure 1, and col. 13, line 61-col. 14, line 4 in Oshio to support his allegations. However, nowhere does this drawing or this passage teach or suggest the novel features of the invention.

Specifically, Figure 1 in Oshio merely discloses a light-emitting element 1 formed on a lead 21 and an encapsulating element 5 formed on the light-emitting element 1. However, Figure 1 does not teach a fluorescent material disposed in a base.

This is made clear in columns 13 and 14 in Oshio, which teach that a fluorescent material can be mixed in the silver paste used to mount the light-emitting element 1 to the lead 21, so that light "emitted to or toward the bottom surface of the element 1 enters into the adhesive 3 containing the fluorescent material, ... and [is] taken out ... through the encapsulating element 5" (Oshio at col. 13, line 66-col. 14, line 4).

Thus, clearly Oshio does not teach or suggest a fluorescent material which is disposed in the base and is adjacent to the substrate and on an opposite side of the substrate from the light-emitting layer as recited, for example, in claim 26. In fact, Oshio is completely unrelated to the claimed invention. Therefore, Oshio clearly does not make up for the deficiencies of the Genriyou/Yamada combination, or the Genriyou/Nemoto/Yamada combination.

Therefore, Applicant submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

IV. FORMAL MATTERS AND CONCLUSION

Applicant notes that the Examiner's objection to claims 19-20, 23 and 38 has been

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addressed by amending claim 19 to delete the "a" in line 4 thereof. Therefore, the Examiner is requested to withdraw the objections to these claims.

In view of the foregoing, Applicant submits that claims 14-16, 18-20, 22-23, 26-36 and 38-39, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

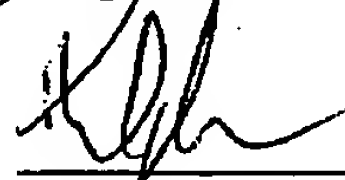
Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date:

9/29/04

Respectfully Submitted,



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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment was filed by facsimile with the United States Patent and Trademark Office, Examiner Eugene Lee, Group Art Unit # 2815 at fax number (703) 872-9306 this 29th day of September, 2004.



Phillip E. Miller

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